

REMARKS

Claims 1, 3, and 7 through 23 are currently pending in the application.

Claims 2 and 4 through 6 have been canceled.

This amendment is in response to the Office Action of June 14, 2004.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on Smith (U.S. Patent 5,860,362)

Claims 1, 2, 4, 9, 10, 12, 14, 15, and 17 through 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smith (U.S. Patent 5,860,362).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After considering the cited prior art, the rejection, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Turning to the cited prior art, the Smith reference describes a system comprising a self-service newspaper vending machine 2 including an electronic control means 34 with an on-line connection 36 to a news providing organization 38 from which a newspaper can be purchased. A customer is shown new stories on a display 6. The customer is given the opportunity of purchasing a newspaper or part of a newspaper. Communication between the customer and the vending machine 2 is by the display 6 and a keyboard 8. The newspaper can be purchased by either inserting a banking or credit card in a card reader 52 or inserting coins into a coin slot 50. The vending machine 2 prints out the news requested.

Applicants assert that the Smith reference does not and cannot anticipate the presently claimed inventions of presently amended independent claims 1, 10, and 14 because the Smith reference does not identically describe, either expressly or inherently, each and every element of the presently claimed inventions in as complete detail as is contained in the claims. For instance, Applicants assert that the Smith reference does not identically describe, either expressly or inherently, the elements of the presently claimed inventions of presently

amended independent claims 1, 10, and 14 calling for “at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”, “providing at least one user profile database for storing demographic information about users of a personalized media service, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”, and “retrieving a set of user preferences corresponding to a user identity from a user profile database, said set of user preferences comprising stored demographic information about a user in said user profile database including information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”.

In contrast to the presently claimed inventions of presently amended independent claims 1, 10, and 14 of the present application, the Smith reference, at best, merely describes a user profile according to the topics, subject and keywords selected by the user in his profile from the raw news sources that are scanned for review by the user.

Therefore, presently amended independent claims 1, 10, and 14 are allowable as well as dependent claims 3, 7 through 9, 11 through 13, and 15 through 23 therefrom.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Smith (U.S. Patent 5,860,362) in view of Nozue et al. (U.S. Patent 5,845,262)

Claims 3, 7, 8, 13 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent 5,860,362) in view of Nozue et al. (U.S. Patent 5,845,262).

Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

After considering the cited prior art, the rejection, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Again turning to the cited prior art, the Smith reference teaches or suggests a system comprising a self-service newspaper vending machine 2 including an electronic control means 34 with an on-line connection 36 to a news providing organization 38 from which a newspaper can be purchased. A customer is shown new stories on a display 6. The customer is given the opportunity of purchasing a newspaper or part of a newspaper. Communication between the customer and the vending machine 2 is by the display 6 and a keyboard 8. The newspaper can be purchased by either inserting a banking or credit card in a card reader 52 or inserting coins into a coin slot 50. The vending machine 2 prints out the news requested.

The Nozue et al. reference teaches or suggests a system for transferring various information of a newspaper, a magazine, an advertisement, or the like by dot data. The information is dispatched from a center to an information vending machine through a satellite line or a terrestrial line. Dispatched press data is accumulated to a recording unit in an information vending machine. When it is identified that an information fee has been paid by cash or a prepaid credit card, desired data in the information accumulated in the recording unit is written into a recording medium such as an IC card or the like of a consumer.

Applicants assert that any combination of the Smith reference and the Nozue et al. reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the inventions of claims 3, 7, 8, 13, and 16 because, at the very least, any combination of the cited prior art fails to teach or suggest all of the claim limitations of presently amended independent claims 1, 10, and 14 from which claims 3, 7, 8, 13, and 16 depend. For instance, Applicant asserts that any combination of the Smith and Nozue et al. reference fails to teach or suggest the claim limitations of presently amended independent claims 1, 10, and 14 calling for "at least one user profile database for storing demographic

information about users of said personalized media service device received from said central processing unit, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”, “providing at least one user profile database for storing demographic information about users of a personalized media service, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”, and “retrieving a set of user preferences corresponding to a user identity from a user profile database, said set of user preferences comprising stored demographic information about a user in said user profile database including information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”.

As previously discussed, in contrast to the presently claimed inventions of presently amended independent claims 1, 10, and 14 of the present application, the Smith reference, at best, merely describes a user profile according to the topics, subject and keywords selected by the user in his profile from the raw news sources that are scanned for review by the user while the Nozue et al. reference teaches or suggests allowing a user to select information from a group of available newspapers, magazines or the like. Applicants assert that such is not the claimed inventions of presently amended independent claims 1, 10, and 14.

Therefore, presently amended independent claims 1, 10, and 14 are allowable as well as dependent claims 3, 7 through 9, 11 through 13, and 15 through 23 therefrom.

Obviousness Rejection Based on Smith (U.S. Patent 5,860,362) in view of Dasan (U.S. Patent 5,761,662)

Claims 5, 6 and 20 through 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent 5,860,362) in view of Dasan (U.S. Patent 5,761,662).

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

After considering the cited prior art, the rejection, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Again turning to the cited prior art, the Smith reference teaches or suggests a system comprising a self-service newspaper vending machine 2 including an electronic control means 34 with an on-line connection 36 to a news providing organization 38 from which a newspaper can be purchased. A customer is shown new stories on a display 6. The customer is given the opportunity of purchasing a newspaper or part of a newspaper. Communication between the customer and the vending machine 2 is by the display 6 and a keyboard 8. The newspaper can be purchased by either inserting a banking or credit card in a card reader 52 or inserting coins into a coin slot 50. The vending machine 2 prints out the news requested.

The Dasan reference teaches or suggests an automatic method and system for retrieving information based on a user-defined profile. The user profile being generated according to the topics, subjects, keywords selected by the user from the raw new sources that are scanned for printing a newspaper for the user.

Applicants assert that any combination of the Smith reference and the Dasan reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the inventions of claims 5, 6, and 20 through 23 because, at the very least, any combination of the cited prior art fails to teach or suggest all of the claim limitations of presently amended independent claims 1 and 14 from which claims 3, 7, 8, 13, and 16 depend. For instance, Applicant asserts that any combination of the Smith and Nozue et al. reference fails to teach or suggest the claim limitations of presently amended independent claims 1, 10, 14 and 14 calling for "at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies,

interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences” and “retrieving a set of user preferences corresponding to a user identity from a user profile database, said set of user preferences comprising stored demographic information about a user in said user profile database including information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”.

As previously discussed, in contrast to the presently claimed inventions of presently amended independent claims 1 and 14 of the present application, the Smith reference, at best, merely describes a user profile according to the topics, subject and keywords selected by the user in his profile from the raw news sources that are scanned for review by the user while the Dasan reference teaches or suggests a user profile according to the topics, subjects, keywords selected by the user from the raw new sources that are scanned for printing a newspaper for the user. Applicants assert that such is not the claimed inventions of presently amended independent claims 1 and 14.

Therefore, presently amended independent claims 1 and 14 are allowable as well as dependent claims 3, 7 through 9, and 15 through 23 therefrom.

Obviousness Rejection Based on Smith (U.S. Patent 5,860,362)

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent No. 5,860,362).

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

After considering the cited prior art, the rejection, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Yet again turning to the cited prior art, the Smith reference teaches or suggests a system comprising a self-service newspaper vending machine 2 including an electronic control means 34 with an on-line connection 36 to a news providing organization 38 from which a newspaper can be purchased. A customer is shown new stories on a display 6. The customer is given the opportunity of purchasing a newspaper or part of a newspaper. Communication between the customer and the vending machine 2 is by the display 6 and a keyboard 8. The newspaper can be purchased by either inserting a banking or credit card in a card reader 52 or inserting coins into a coin slot 50. The vending machine 2 prints out the news requested.

Applicants assert that Smith reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the invention of claims 11 because, at the very least, any combination of the cited prior art fails to teach or suggest all of the claim limitations of presently amended independent claims 10 from which claim 11 depends. For instance, Applicant asserts that the Smith reference fails to teach or suggest the claim limitations of presently amended independent claim 10 calling for “at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences”.

As previously discussed, in contrast to the presently claimed inventions of presently amended independent claim 10 of the present application, the Smith reference, at best, merely describes a user profile according to the topics, subject and keywords selected by the user in his profile from the raw news sources that are scanned for review by the user. Applicants assert that such is not the claimed invention of presently amended independent claim 10.

Therefore, presently amended independent claim 10 is allowable as well as dependent claims 11 through 13 therefrom.

In summary, Applicants submit that claims 1, 3, and 7 through 23 are clearly allowable over the cited prior art for the reasons set forth herein.

Applicants request the allowance of claims 1, 3, and 7 through 23 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, reading "James R. Duzan". The signature is written in a cursive style with a large, stylized 'J' and 'D'.

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